

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	POST	Examiner:	TARA L. MAYO
Serial No.:	10/649,152	Group Art Unit:	3671
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Confirmation No.:	5019		
Title:	RESCUE UNDERLAY FOR MATTRESSES		

POSITION IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

In support of Applicants' Pre-Appeal Brief Request for Review Applicant submits the following remarks.

A brief explanation of Applicant's invention is provided starting on page 6 of the December 14, 2005 response and bridging page 7. In summary, Applicant's invention is directed to a rescue underlay for a mattress where the underlay comprises a spacer woven fabric. The rescue underlay is designed to be used for transporting patients in emergency situations over the ground and in stairwells. The additional cushioning, or spring travel, provided by the rescue underlay is important especially when carrying a patient down the stairs on a mattress.

Claims 16-45 are currently under final rejection under § 103(a) as unpatentable over the prior art of record, namely Hemphill (U.S. Pat. No. 5,150,487) and Bottger et al. (U.S. Pat. No. 5,582,893). Additionally, some claims are further rejected in view of Failor (U.S. Pat. No. 5,860,174).

In order to make a *prima facie* case of obviousness there must be (1) a suggestion or motivation in either the references or the knowledge generally available to a person of skill in the art; (2) a reasonable expectation of success; and (3) the references or a combination must teach or suggest all of the claim limitations. See MPEP § 2143. The Office Actions of November 4,

2005 and March 3, 2006 do not set forth a *prima facie* case of obviousness because the references do not provide a suggestion or motivation, and a reasonable expectation or success.

I. The Office Actions of November 4, 2005 and March 3, 2006 lack an essential element necessary to establish a *prima facie* case of obviousness, i.e., the requisite showing of a proper suggestion or motivation to modify Hemphill to achieve the rescue underlay of claim 16.

The December 14, 2005 response to the Office Action of November 4, 2005 highlights the lack of a proper suggestion or motivation to modify Hemphill, and Applicant specifically points to the paragraph on page 7 bridging page 8, all of page 8, and on to page 9. In summary, Hemphill does not describe or characterize either a base sheet or support member in terms of its tensile strength or spring travel nor does it state that a base sheet or support member that has a relatively high tensile strength or improved spring travel would work with the invention disclosed in Hemphill or would be desirable. On the contrary, Hemphill actually teaches away from a base sheet or support member that provides spring travel because it states that “the support member (2) provides a relatively rigid flat surface covered by a base sheet (1).” Hemphill, column 4, lines 24-27. A rigid flat surface is contradictory to the purpose of the present invention which is a rescue underlay that provides spring travel. See MPEP §2145. In addition to teaching away from the present invention, this same passage from Hemphill teaches away from a combination of Hemphill and Bottger et al. Hemphill calls out a rigid flat surface and Bottger et al. calls out a spacing fabric. It is improper to combine references where the references teach away from the combination. See MPEP §2145.

Bottger et al. does not remedy the shortcomings of Hemphill. Bottger et al. is directed to a spacing fabric for use in reinforcing structural components such as metallic plates, or containers such as tanks. Bottger et al., column 2, lines 20-35. The fabric in Bottger et al. is

designed to be flat for a period of time and then expand upon heating or other act to form two layers spaced apart. Id. Bottger et al. does not teach or suggest that the spacing fabric can be used with rescue mats such as those described in Hemphill, or in the present invention. Further, the spacing fabric described in Bottger et al., i.e., a spacing fabric that starts out as two layers that touch and expand upon heating or other act to two layers spaced apart, would not be desirable or appropriate in the present invention where the purpose is to rescue people in an emergency and the layers need to come spaced apart versus expanding upon heating.

Applicant respectfully submits that the motivation to combine Hemphill with Bottger et al. would not come from a person having ordinary skill in the art of making beds. Bottger et al. is not analogous prior art. A person of ordinary skill in the art of making beds would not look to the construction arts or to methods of reinforcement in construction in order to find materials that would be useful for rescue mats. In order to rely on a reference as a basis for a rejection, the reference must be in applicant's field of endeavor or reasonably pertinent. MPEP §2141.01(a). This is not the case with Bottger et al. This is further exemplified by the fact that neither Hemphill nor Bottger et al. include a reference or teaching to the other, making it even less likely that the motivation would have come from a person skilled in the art of making beds.

II. The Office Actions of November 4, 2005 and March 3, 2006 lack an essential element necessary to establish a *prima facie* case of obviousness, i.e., a reasonable expectation of success that the combination of Hemphill and Bottger et al. would be effective as a rescue underlay like that described in claim 16.

Applicant submits that there is not a reasonable likelihood of success that the reinforcement fabric of Bottger et al. could be combined with the invention in Hemphill to create a rescue underlay for mattresses having spacer woven fabric. As discussed above, the spacer

fabric in Bottger et al. starts out as two layers that touch and expand upon heating or other act to form two layers spaced apart. Even if a person skilled in the art of making beds would look to Bottger et al. and the construction arts, a person skilled in the art could not reasonably expect the combination of Bottger et al. and Hemphill to succeed if the spacer fabric of Bottger et al. has to be heated or otherwise made to expand in order to provide spring travel.

The shortcomings of Bottger et al. and Hemphill are not remedied by Failor. Because the cited references do not include a motivation or teaching to combine them, do not include a reasonable likelihood of success, and use non-analogous art, Applicant believes the rejections under §103(a) should be withdrawn.

Please charge any additional fees or credit overpayment to Deposit Account No. 501257.



Respectfully submitted,

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